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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,040	06/28/2006	Mark Alan Lamonte Johnson	297/171 PCT/US	8058

25297 7590 03/06/2009
JENKINS, WILSON, TAYLOR & HUNT, P. A.
Suite 1200 UNIVERSITY TOWER
3100 TOWER BLVD.,
DURHAM, NC 27707

EXAMINER

KIEBIDE, BROOK

ART UNIT

PAPER NUMBER

2894

MAIL DATE

DELIVERY MODE

03/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/550,040

Applicant(s)

JOHNSON ET AL.

Examiner

Brook Kebede

Art Unit

2894

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15, 16, 25, 26, 31, 34, 38, 39 and 41-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34, 38, 39 and 41-50 is/are allowed.
- 6) ☒ Claim(s) 15, 16, 25 and 31 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Remarks

1. **The instant application is made Non-Final because claim 16 inadvertently has not been treated in the Office action that was mailed May 15, 2008.**

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 15, 16, 25 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Lyons et al. (US 6,291,137).**

Re claims 15, 25 and 31, Lyons et al. disclose a FET semiconductor device having a nano-pitched feature (12) formed by edge definition lithography process (see Figs. 1-5 and related text Col. 3, line 13 - Col. 9, line 21).

With respect to the process claim, the claim has not given patentable weight because the process does not resulted patentable device or device structure that different form the prior art. Furthermore, patentability of a product does not depend on its method of production. “If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Re claim 16, Lyons et al. disclose a plurality of multi-periodic electromechanical device having a nano-pitched feature (12) formed by edge definition lithography process (see Figs. 1-5 and related text Col. 3, line 13 - Col. 9, line 21).

With respect to the process claim, the claim has not given patentable weight because the process does not resulted patentable device or device structure that different form the prior art. Furthermore, patentability of a product does not depend on its method of production. "If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Allowable Subject Matter

5. Claims 34, 38, 39 and 41-50 are allowed over prior art of record.
6. Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicants' arguments with respect to claims 26, 34, 38, 39 and 41-50 have been considered but are moot in view of the allowable subject matter set forth above.
8. Applicants' arguments filed on November 17, 2008 with respect to claims 15, 16, 25, and 31 have been fully considered but they are not persuasive.

With respect to rejection of claims 15, 16, 25 and 31 under 35 U.S.C. 102, Applicants argue that "there is absolutely no disclosure, teaching, or suggestion in Lyons of a semiconductor structure that includes plural nanometer-pitched channels formed by adjacent nanometer-pitched sidewalls of alternating masking material..."

In response to Applicants arguments, it is respectfully submitted there is no structurally distinct device is claimed in the rejected claims. Furthermore, Applicants did not claim the device structure that defined by the process. Therefore, the process has not given any patentable weight. A "product-by-process" claim is one in which the product is defined at least in part in terms of the method or process by which it is made. *Atlantic Thermoplastics Co. Inc. v. Faytex Corp.*, 23 USPQ2d 1481, 1488 (Fed. Cir 1992). Although it is noted that claim(s) 15, 16, 25 and 31 are product-by-process claims, product-by-process claims are directed to the product no matter how actually made. *In re Taylor*, 149 USPQ 615, 617 (CCPA 1966). Consequently, it is the

patentability of the final product, and not the patentability of the process, that must be determined in a product-by-process claim. *In re Thorpe*, 227 USPQ 964, 966 (CAFC 1985), *Ex parte Edwards* 231 USPQ 981, 983 (BdPatApp&Int 1986).

Further in response to applicants' argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., structure that includes plural nanometer-pitched channels) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, the rejection of claims 15, 16, 25 and 31 under 35 U.S.C. 102 is deemed proper.

Conclusion

9. **THIS ACTION IS NON-MADE FINAL.**

Correspondence

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brook Kebede whose telephone number is (571) 272-1862. The examiner can normally be reached on 8-5 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly D. Nguyen can be reached on (571) 272-2402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brook Kebede/
Primary Examiner, Art Unit 2894

/BK/
March 1, 2009